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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,586

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Michael D. Ellis

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EXAMINER

GRAHAM, PAUL J

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/723,586	Applicant(s) ELLIS ET AL.	
	Examiner PAUL J. GRAHAM	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 200-219 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 200-219 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/11/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Information Disclosure Statement

The references listed on the Information Disclosure statement filed on 6/11/08 have been considered by examiner (see attached PTO-1449).

Response to Arguments

1. Applicant Argues:

Banker does not suggest how multiple tuners could work in context of IPG

The Examiner respectfully disagrees. Banker shows that multiple tuners may be used in conjunction with user's desire to have interactive services provided them (see Banker, col. 2, l. 60-col. 3, l. 10, col. 16, l. 5-40). Said tuners work via user decision-making and selection which stems from use of an interactive program guide (see Banker, col. 6, ll. 28-67, col. 11, l. 25-35, col. 15, ll. 35-50) which definitely shows how multiple tuners can work in context of a program guide.

Reading the claims in the broadest sense, Banker certainly does multiple tuners working in the context of an interactive program guide. Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988, F.2d 1181,26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant's arguments have been considered in full and are not persuasive.

The claims 200-219 stand rejected.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 200-201, 205-207, 209-211, 215-217, 219** are rejected under 35 U.S.C. 102(b) as being unpatentable over Banker (US Patent Number 5,485,221).

Regarding **claims 200, 210**, Banker discloses user television equipment, method, and machine readable medium that allows a user to watch one television program on a viewing device while simultaneously recording another television program (see column 9, lines 33-51) (see also column 16, lines 23-37), said user television equipment comprising: a digital storage device (see column 7, lines 27-35); a first tuner (see Figure 2, element 100) coupled to said viewing device (see column 9, lines 33-51); a second tuner (see column 9, line 38) (see column 16, lines 23-32) coupled to said digital storage device (see Figure 2); and an interactive television program guide implemented on said user television equipment (see column 6, lines 28-67; lines 1-12), said interactive television program guide configured to: cause said viewing device to display a program guide display (see Figure 5a, 5b, 5c); receive a user selection to watch a first television program indicated on said program guide display (see Figure 5a, Screen 100); receive a user selection to record a second television program indicated on said program guide display (see

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column 16, lines 33-37); cause said first tuner to tune to a channel corresponding to said first television program in order to cause said first television program to be displayed by said viewing device (see column 9, lines 33-51) (see also column 16, lines 23-37); and cause said second tuner to tune to a channel corresponding to said second television program in order to cause said second television program to be recorded by said digital storage device (see column 9, lines 33-51) (see also column 16, lines 23-37), wherein broadcast times of said first television program and said second television program overlap such that said first television program is displayed by said viewing device at the same time that said second television program is recorded by said digital storage device (i.e. simultaneous) (see column 9, lines 33-51) (see also column 16, lines 23-37, Banker shows that multiple tuners may be used in conjunction with user's desire to have interactive services provided them (see Banker, col. 2, l. 60-col. 3, l. 10, col. 16, l. 5-40). Said tuners work via user decision-making and selection which stems from use of an interactive program guide (see Banker, col. 6, ll. 28-67, col. 11, l. 25-35, col. 15, ll. 35-50) which definitely shows how multiple tuners can work in context of a program guide).

Regarding **claims 201, 211**, Banker discloses everything as claimed above (see claims 200, 210). In addition, Banker discloses the user television equipment, method, and machine readable medium, wherein said interactive television program guide is further configured to use said second tuner to perform a function other than program recording (e.g. display a pip screen) (see Figure 1C).

202.

Regarding **claims 205, 215**, Banker discloses everything as claimed above (see claims 201, 211). In addition, Banker discloses the user television equipment, method, and machine readable medium wherein said interactive television program guide is further configured to cause said viewing device to display an option to cancel recording of said second television program when said function other than program recording is initiated during said recording of said second television program (see column 14, lines 27-36).

Regarding **claims 206, 216**, Banker discloses everything as claimed above (see claims 200, 210). In addition, Banker discloses the user television equipment, method, and machine readable medium further comprising switching circuitry having a first input coupled to said first tuner, a second input coupled to said second tuner, a first output coupled to said viewing device, and a second output coupled to said digital storage device, wherein said interactive television program guide is further configured to cause said switching circuitry to dynamically couple said first tuner to said viewing device and to dynamically couple said second tuner to said digital storage device (see column 16, lines 20-55) (see Figure 2).

Regarding **claims 207, 217**, Banker discloses everything as claimed above (see claims 200, 210). In addition, Banker discloses the user television equipment, method, and machine readable medium wherein said interactive television program guide is configured to cause said viewing device to display a first program listing corresponding to said first television program and to display a second program listing corresponding to said second television program (see column 9, lines 33-51) (see also column 16, lines 23-37).

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Regarding **claims 209, 219**, Banker discloses everything as claimed above (see claims 200, 210). In addition, Banker discloses the user television equipment, method, and machine readable medium wherein said first tuner and said second tuner are included in a single set-top box (see column 9, lines 37-40) (See Figure 2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. **Claims 202-204, 208, 212-214, 218** are rejected under 35 U.S.C. 103(a) as being unpatentable over Banker et al. (US Patent Number 5,485,221) in view of Ellis et al. (US Patent Number 5,986,650).

Regarding **claims 202, 212**, Banker discloses everything as claimed above (see claims 201, 211). In addition, Banker discloses the user television equipment, method, and machine readable medium wherein said function other than program recording is selected from the group consisting of providing a picture- in-picture

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signal (see column 8, lines 55-67), collecting program guide data (see column 16, lines 38-54), browsing the Internet, and playing a music channel (see column 16, lines 38-54).

However, Banker does not explicitly disclose a tuner providing a function of browsing the internet.

Nevertheless, it is old and well known at the time of Applicant's invention to use a plurality of tuners, and to have a tuner to assist in browsing the internet while the other tuner performs a different function. This would be a simple modification to Banker's invention by one of ordinary skill in the art.

Regarding **claims 203, 213**, Banker discloses everything as claimed above (see claims 201, 211). In addition, Banker discloses the user television equipment, method, and machine readable medium wherein said interactive television program guide is configured to cause said second tuner to tune to said channel corresponding to said second television program when said second television program is about to begin regardless of whether said second tuner is being used to perform said function other than program recording when said second television program is about to begin.

However, Banker does not disclose any of the tuners to tune to another television channel regardless of whether second tuner is performing another function other than program recording when said second television program is about to begin.

In an analogous art, Ellis (Patent # 5,986,650) discloses an EPG display with a watch/record schedule to cause a tuner to automatically tune to another television

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channel even if that tuner is performing another function, such as being tuned to a different television channel (see column 14, lines 27-36).

It would have been obvious at the time of Applicant's invention for one of ordinary skill in the art to implement the technique of having one tuner tune to a different channel to record while the other tuner performs another function, for the convenience of a user who wished to set a schedule of records and use a tuner to perform another function.

Regarding **claims 204, 214**, Banker discloses everything as claimed above (see claims 201, 211).

However, Banker does not disclose canceling a recording.

In an analogous art, Ellis (US Patent #5,986,650) discloses the user television equipment, method, and machine readable medium wherein said interactive television program guide is further configured to cause said viewing device to display an option to cancel recording of said second television (see column 14, lines 27-36) program when said second tuner is being used to perform said function other than program recording at the time said second television program is about to begin.

It would have been obvious at the time of Applicant's invention to modify Banker's invention to include displaying an option for cancelling a recording of a television program at a time before the television program begins for the user convenience that a user may change their mind about using their resources such as a tuner for recording a program that the user scheduled weeks before.

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Regarding **claims 208, 218**, Banker discloses everything as claimed above (see claims 200, 210).

However, Banker does not disclose cursors for highlighting program listings.

In an analogous art, Ellis (US Patent #5,986,650) discloses the user television equipment, method, and machine readable medium wherein said interactive television program guide is configured to receive said user selection to watch said first television program from a remote control when said first program listing is highlighted by a cursor and to receive said user selection to record said second television program from said remote control when said second program listing is highlighted by a cursor (see column 16, lines 48-67).

It would have been obvious at the time of Applicant's invention for one of ordinary skill in the art to include cursors when selecting program listings to simplify the interface for the predictable result of user-friendliness.

Conclusion

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the

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advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul J. Graham whose telephone number is 571-270-1705. The examiner can normally be reached on Monday-Friday 8:00a-5:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or

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access to the automated information system, call 800-786-9199 (IN USA OR
CANADA) or 571-272-1000.

pjg
9/22/08

/Vivek Srivastava/

Supervisory Patent Examiner, Art Unit 2623